



**UNITED STATES DEPARTMENT OF COMMERCE  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/971,172	11/14/97	GOODMAN	C

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HM21/0914

EXAMINER

BAKALYAR, H

ART UNIT

PAPER NUMBER

1645

DATE MAILED: 09/14/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
**08/971,172**

Applicant(s)  
**Goodman**

Examiner  
**Heather Bakalyar**

Group Art Unit  
**1645**



☒ Responsive to communication(s) filed on Nov 14, 1997

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 0 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-9 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 1-9 are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## DETAILED ACTION

### *Election/Restriction*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-3, 7 drawn to Robo protein, classified for example in class 530, subclass 350.
  - II. Claims 4-6, 8, drawn to nucleic acid encoding Robo protein, classified for example in class 536, subclass 23.1.
  - III. Claim 9, drawn to methods of modulating cell function comprising an agent which modifies activity of Robo protein, classified for example in class 514, subclass 2.
  - IV. Claim 9, drawn to methods of modulating cell function comprising an agent which modifies activity of a Robo gene, classified for example in class 514, subclass 2.
2. The inventions are distinct, each from the other because of the following reasons:
3. Inventions I-II are related as products. Inventions I-II are distinct, each from the other, because the products are comprised of different building blocks (e.g. amino acids vs nucleotides) have different chemical formula, distinct primary, secondary and tertiary structures, and different modes of action and effects.
4. Inventions III-IV are related as methods. Inventions III-IV are distinct, each from the other, because the agents utilized in the methods are functionally distinct (e.g. modulate Robo gene activity vs Robo protein activity) and therefore are presumed to be structurally divergent. Similarly, the method steps of the Inventions, e.g. modulation of gene activity vs modulation protein activity, are distinct, and encompass different patentability issues.
5. These inventions are distinct for the reason given above and have acquired a separate status in the art because of their recognized divergent subject matter. Therefore, restriction for

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examination purposes as indicated is proper. In addition, prior art searches require non-patent literature searches. The literature search for the invention of any Group would not be expected to reveal all the relevant references for the inventions of the remaining Groups.

6. This application contains claims directed to the following patentably distinct species of the claimed invention:

In each of Groups III and IV, the (a) polypeptide agent and (b) antibody agent comprise distinct primary, secondary and tertiary structure, as well as distinct biological function (e.g. binding specificity, etc).

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, (a) polypeptide agent or (b) antibody agent, for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 9 is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

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Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

7. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

8. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

9. Any inquiry of a general nature or relating to the status of this general application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Papers relating to this application may be submitted to Technology Center 1600, Group 1640 by facsimile transmission. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). Should applicant wish to FAX a response, the current official FAX number for Group 1600 is (703) 308-4242.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Heather Bakalyar, whose telephone number is (703) 305-7143. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula Hutzell, Ph.D., can be reached at (703) 308-4310.

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Heather A. Bakalyar, Ph.D.  
Patent Examiner  
9/11/98



PAULA K. HUTZELL  
SUPERVISORY PATENT EXAMINER